

ESTTA Tracking number: **ESTTA202071**

Filing date: **04/01/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Nordstrom, Inc.		
Entity	Corporation	Citizenship	Washington
Address	1617 Sixth Avenue, Suite 500 Seattle, WA 98101 UNITED STATES		

Attorney information	William O. Ferron, Jr. Seed IP Law Group PLLC 701 Fifth Avenue, Suite 5400 Seattle, WA 98104 UNITED STATES billf.docketing@seedip.com, litcal@seedip.com Phone:206-622-4900
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### Applicant Information

Application No	77289972	Publication date	03/25/2008
Opposition Filing Date	04/01/2008	Opposition Period Ends	04/24/2008
Applicant	L. Justin Gayle 4900 Sweetwater College Station, TX 77845 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Belts; Caps; Tops; Hunting vests; Camp shirts; Long-sleeved shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; T-shirts; Tee shirts; Cargo pants; Pants; Golf shirts; Knit shirts; Open-necked shirts; Polo shirts; Bib overalls; Overalls; Working overalls; Coveralls; Hats; Baseball caps; Cap visors; Caps with visors; Knitted caps; Jackets; Men and women jackets, coats, trousers, vests
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Res judicata, J.I. Case Co. v. F.L. Industries, Inc., 229 USPQ 697 (TTAB 1986)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1409938	Application Date	01/31/1986
Registration Date	09/16/1986	Foreign Priority	NONE

		Date	
Word Mark	NORDSTROM RACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1972/10/00 First Use In Commerce: 1972/10/00 RETAIL MEN'S AND WOMEN'S CLOTHING STORE SERVICES		

U.S. Registration No.	2980055	Application Date	10/16/2002
Registration Date	07/26/2005	Foreign Priority Date	NONE
Word Mark	NORDSTROM RACK NR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2001/04/00 First Use In Commerce: 2001/04/00 Retail store and online retail services, all in the field of apparel, footwear, small leather goods, eyewear, jewelry, and bath, body and personal care products; retail and online retail gift shop services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	RACK		
Goods/Services	Retail men's and women's clothing store services		

Attachments	78976100#TMSN.gif ( 1 page )( bytes ) SP-NoticeOpposition-BIGRACK.PDF ( 6 pages )(147829 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/William O. Ferron, Jr./
Name	William O. Ferron, Jr.
Date	04/01/2008

THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NORDSTROM, INC.,	)	
	)	
Opposer,	)	Opposition No. _____
	)	
v.	)	Serial No. 77/289972
	)	
L. JUSTIN GAYLE,	)	
	)	
Applicant.	)	Attorney Docket No. 700043.80063
_____	)	

**NOTICE OF OPPOSITION**

Opposer Nordstrom, Inc. ("Nordstrom"), which has a place of business at 1617 Sixth Avenue, Suite 500, Seattle, Washington 98101, believes that it will be damaged by registration of the mark BIG RACK SPORTSWEAR shown in United States Trademark Application Serial No. 77/289972 ("the '972 Application"), filed September 26, 2007, in class 25 by L. Justin Gayle ("Applicant"), and published for opposition on March 25, 2008. Nordstrom therefore opposes that application.

The grounds for this Opposition are as follows:

1. Opposer is a retail department store engaged in the marketing and sale of a wide variety of men's, women's and children's clothing and accessories in interstate commerce.
2. Commencing at least as early as October 1972, Opposer adopted and has continuously used the marks RACK, NORDSTROM RACK, THE RACK and variants thereof ("Nordstrom's RACK Marks") in interstate commerce in the United States as trademarks in

connection with retail men's and women's clothing store services and has been selling men's and women's clothing in its Nordstrom's RACK stores, including, but not limited to, shirts, jackets, pants, T-shirts, sweatshirts, underwear and sleepwear.

3. Opposer applied for and received U.S. Trademark Registration No. 1,409,938 for the mark NORDSTROM RACK for retail men's and women's clothing store services in class 42. The registration is valid and subsisting and has become incontestable.

4. Opposer also applied for and received U.S. Trademark Registration No. 2,980,055 for the mark NORDSTROM RACK NR for retail store and online retail services, all in the field of apparel, footwear, small leather goods, eyewear, jewelry, and bath, body and personal care products; and retail and online retail gift shop services, in class 42. The registration is valid and subsisting.

5. Opposer's U.S. Trademark Registration Nos. 1,409,938 and 2,980,055 have been assigned by Opposer to NIHC, Inc. ("NIHC"), a wholly owned and controlled subsidiary of Opposer. The marks shown in the registrations have been exclusively licensed to Opposer by NIHC.

6. Since commencing use of the Nordstrom's RACK Marks as described above, Opposer has generated substantial revenue from the sale of goods in connection with the marks in the United States. Additionally, Opposer has expended substantial sums of money, time and effort in advertising, promoting and popularizing the Nordstrom's RACK Marks in the United States.

7. As a result of Opposer's use of the Nordstrom's RACK Marks, and its advertising and promotion of its Nordstrom's RACK retail clothing store services and clothing and related products sold in connection with those services, the Nordstrom's RACK Marks have become well known in the United States and are recognized as identifying the high-quality services and goods of Opposer. Thus, Opposer's Nordstrom's RACK Marks and the associated goodwill are valuable assets of Opposer.

8. Applicant has applied to register BIG RACK SPORTSWEAR for belts, caps, tops, hunting vests, camp shirts, long-sleeved shirts, shirts, short-sleeved or long-sleeved t-shirts, short-sleeved shirts, sport shirts, sports shirts, sports shirts with short sleeves, sweat shirts, t-shirts, tee shirts, cargo pants, pants, golf shirts, knit shirts, open-necked shirts, polo shirts, bib overalls, overalls, working overalls, coveralls, hats, baseball caps, cap visors, caps with visors, knitted caps, jackets, and men and women jackets, coats, trousers and vests in class 25. The goods described in Applicant's application are so closely related to Opposer's retail store clothing services and the clothing sold in Opposer's retail stores that confusion is likely to result if the parties' respective goods and services are marketed and sold under the same or confusingly similar marks.

9. The mark BIG RACK SPORTSWEAR for the goods described in the '972 Application is confusingly and deceptively similar to Opposer's Nordstrom's RACK Marks for Opposer's above-described services, such that the trade and purchasing public will be confused by and deceived into believing that Applicant's goods originate with Opposer, or are otherwise authorized by, sponsored by, licensed by, affiliated with, or associated with Opposer.

10. Upon information and belief, Applicant has not made use of the mark BIG RACK SPORTSWEAR as a trademark in connection with the goods listed in the application, or in connection with any other goods or services, in interstate commerce in the United States or in commerce between the United States and any foreign country, prior to Opposer's first use of its Nordstrom's RACK Marks.

11. Upon information and belief, Applicant has not made use of the mark BIG RACK SPORTSWEAR as a trademark in connection with the goods listed in the application, or in connection with any other goods or services, in interstate commerce in the United States, or in commerce between the United States and any foreign country, prior to the filing date of Applicant's intent-to-use application.

12. Upon information and belief, Applicant does not have a bona-fide intent to use the mark BIG RACK SPORTSWEAR for all of the goods listed in its application.

13. Previously on September 8, 2006, Applicant filed U.S. Trademark Application Serial No. 78/709081 ("the '081 Application") to register the identical BIG RACK SPORTSWEAR mark for baseball caps, belts, bib overalls, camp shirts, cap visors, caps, caps with visors, coveralls, dress shirts, dusters, golf caps, golf shirts, hats, hoods, jackets, knit shirts, leather belts, men and women jackets, coats, trousers, vests, open-necked shirts, overalls, pants, polo shirts, shirts, short-sleeved or long-sleeved t-shirts, short-sleeved shirts, sort shirts, sports shirts, sports shirts with short sleeves, sweat shirts, t-shirts, tops and working overalls. A true and correct copy of the USPTO TARR status print-out is attached hereto as Exhibit 1.

14. Opposer filed Opposition No. 91174041 to Applicant's '081 Application on November 19, 2006 and a default judgment sustaining the opposition and refusing registration was rendered against Applicant by the Board on March 16, 2007. A true and correct copy of said default judgment is attached hereto as Exhibit 2.

15. Applicant is precluded from registering BIG RACK SPORTSWEAR for the goods identified in the '972 Application on established principles of res judicata. *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748 (Fed. Cir. 2007) (res judicata protects against relitigation of a previously adjudicated claims); *See International Nutrition Co. v. Horphag Research Ltd.*, 55 USPQ2d 1492 (Fed. Cir. 2000) (default judgment final judgment on the merits for res judicata purposes); *See J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697 (TTAB 1986); *see also Calavo Growers, Inc. v. Luis Calvo Sanz, S.A.*, 2007 WL 1144944 (TTAB 2007).

16. The BIG RACK SPORTSWEAR mark for which Applicant seeks registration here is identical to the mark for which it sought registration in the '081 Application. Moreover, all of the goods identified in the '972 Application are identical to or fully encompassed by the goods identified in the '081 Application. Specifically, 30 of the 35 identified goods (including repeated goods) are identical, whereas hunting vests; long-sleeved shirts; tee shirts; cargo pants;

and knitted caps in the '972 Application are fully encompassed by men and woman vests; shirts; t-shirts; and caps in the '081 Application, respectively.

17. By reason of the foregoing, Opposer would be greatly damaged by the registration of the mark BIG RACK SPORTSWEAR to Applicant.

WHEREFORE, Opposer prays that this Opposition be sustained, Applicant's application denied and the mark refused registration.

Correspondence Address

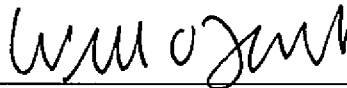
Please direct all communications to:

William O. Ferron, Jr.  
BillF.docketing@SeedIP.com  
SEED IP Law Group PLLC  
701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092

DATED this 1<sup>st</sup> day of April, 2008.

Respectfully submitted,

SEED IP Law Group PLLC



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William O. Ferron, Jr.  
701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Telephone (206) 622-4900  
Facsimile: (206) 682-6031

Attorneys for Opposer  
NORDSTROM, INC.

CERTIFICATE OF SERVICE

I hereby certify that on this 1<sup>st</sup> day of April, 2008, the foregoing **NOTICE OF OPPOSITION** was served upon Applicant's attorney of record by depositing same with the U.S. Postal Service, first-class postage prepaid, addressed as follows:

Derek Gilliland, Esq.  
Nix, Patterson & Roach, L.L.P.  
5215 North O'Connor Drive, Suite 1900  
Irving, Texas 75039



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Annette Baca